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EXAMINER

MATTISON, LORI K

ART UNIT	PAPER NUMBER
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1619

NOTIFICATION DATE	DELIVERY MODE
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03/16/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/584,727	Applicant(s) SAKAKIBARA, ITSUO	
	Examiner LORI MATTISON	Art Unit 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/01/2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 9-11, 14, and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 12, 13 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1-20 are pending. Claims 9-11, 14, and 15 are withdrawn.
2. Applicant's amendments to claims 1, 7, and 18-20 filed 3/01/2010 are acknowledged.

Claims 1-8, 12, 13, and 16-20 are pending and examined on the merits.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Objections and rejections not recited in this action are withdrawn.
5. References not included with this Office action can be found in a prior action.

New Matter

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-8, 12, 13, and 16-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Instant claim 1 recites that limitation that the composition does not comprise a fragrant material. There is no *ipsis verbis* support for such a claim limitation. Nowhere is it stated in the instant specification that fragrant materials are absent from the costumizer. Moreover, paragraph 29 of the instant specification teaches compounding the composition with fragrant materials rather than supporting the instant amendment. Given this disclosure,

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and the absence of any explicit teaching to exclude fragrant materials from the composition, the ordinary artisan would not think that applicants were in possession of the instantly claimed invention. In absence of explicit support for the exclusion of fragrant materials, specifically, the recitation "...wherein the composition does not comprise a fragrant material" in claim 1 is new matter and must be removed from the claims.

Instant claim 1 now recites limitations which were not clearly disclosed in the specification as filed. These limitations now change the scope of the instant disclosure. Such limitations recited by instant claim 1, which did not appear in the specification as filed, introduce new concepts and violate the description requirement 35 USC 112, first paragraph. Applicant is required to provide sufficient written support for the limitations recited in instant claim 1 in the specification or the claims, as-filed, or remove these limitations from the claims in response to this office action.

Because claims 2-8, 12, 13, and 16-20 depend from instant claim 1, they must also be rejected under 35 USC 112, 1st paragraph.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8, 12, 13, and 16-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Instant claim 1 recites the limitation, 'wherein the composition does not comprise a fragrant material.' It is unclear what is meant by "fragrant material" and thus the metes and bounds of instant claim 1 are unclear. The instant specification does not teach or define what a fragrant material is. Furthermore, materials taught and recited for inclusion in the compositions, i.e. rosin and Vaseline, are known to have an odor. Rosin is known to have a pine odor (see evidentiary reference: Allergic to Rosin?, page 3 of 7, paragraphs 7 and 9). Vaseline is known to have a petroleum smell (see evidentiary reference: Vaseline, page 1 of 5, paragraph 2).

Because claims 2-8, 12, 13, and 16-20 depend from instant claim 1, they must also be rejected under 35 USC 112, second paragraph.

Claim 20 also contains the trademark/trade name, "Vaseline." Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Interpretation of Instant Claims 1 and 20: As discussed above, "fragrant materials" is an indefinite term. The composition of instant claim 1 has been interpreted as not comprising perfumes. With regard to instant claim 20, Vaseline has been broadly interpreted as petroleum jelly/petrolatum since Vaseline comprises petroleum jelly/petrolatum.

With regard to the transitional phrase, "consisting essentially of," M.P.E.P. § 2111.03 states, "the transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original) (Prior art hydraulic fluid required a dispersant which appellants argued was excluded from claims limited to a functional fluid "consisting essentially of" certain components. In finding the claims did not exclude the prior art dispersant, the court noted that appellants' specification indicated the claimed composition can contain any well-known additive such as a dispersant, and there was no evidence that the presence of a dispersant would materially affect the basic and novel characteristic of the claimed invention.

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In the instant application, the instant specification teaches that the hair cosmetizer may be compounded with coloring materials and known materials having been used in hair cosmetizers (instant specification, page 7, paragraph 29).

M.P.E.P. § 2111.03 also instructs, “ For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, “consisting essentially of” will be construed as equivalent to “comprising.” In the instant case, the instant specification and instant claims do clearly indicate what the basic and novel characteristics are.

Lastly, M.P.E.P. § 2111.03 also directs "If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of “consisting essentially of,” applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant’s invention. *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also *Ex parte Hoffman*, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989). M.P.E.P. § 2111.03

Claims 1, 3, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,574,011 (Tein, 1996).

Example V of Tein teaches an intra-nasal formulation for treating male pattern baldness (column 18, lines 60-end; column 19, lines 1-10; title). The paste mixture comprises 90% petrolatum (i.e. oily material soluble at room temperature; instant claims 1 and 18) and 0.7% carboxymethyl cellulose (i.e. water soluble organic

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medium; instant claims 1 and 3). The composition would be expected to disperse in water because it comprises carboxymethyl cellulose which would swell in the presence of water and breakup the composition. Fragrance/fragrant material is absent from the composition as required by instant claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim Interpretation: Instant claims 1 and 20 have been interpreted as discussed above.

Claims 1, 3, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,574,011 (Tein, 1996).

Summary of the claim: The oily material may be wax (instant claim 18).

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The limitations of instant claims 1, 3, and 20 have been addressed above.

Tein teaches that petroleum and lanolin are functionally equivalent oleaginous bases for use for the topical administration of the composition (column 15, lines 45-50). One of ordinary skill in the art would recognize that lanolin is a wax comprising a mixture of fatty acids with high molecular weight alcohols.

Example V of Tein does not embody wax as the oil material as set forth by instant claim 18.

With regard to instant claim 18, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have substituted the wax, lanolin, for the petroleum (i.e. vaseline) in the composition of Example 5 because Tein teaches lanolin (i.e. a wax) and petroleum (i.e. vaseline) to be functionally equivalent oleaginous bases for topical administration (column 15, lines 40-55). The skilled artisan would have been motivated to do so in order to provide a less greasy, less occlusive intranasal composition which soothes the skin of the nasal passages. The skilled artisan would have had an expectation of success because Tein explicitly teaches wax (i.e. lanolin) and petroleum as oleaginous bases for use in his invention (column 15, lines 40-55).

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tein as applied to claims 1, 3, 18, and 20 above, and further in view of US Patent No. 4,731,241 (Yamada, 1988).

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Summary of the Claim: The oily material of the composition is recited to be animal fat.

Tein is relied upon as above.

Tein does not teach a composition in which the oily material is animal fat.

Yamada teaches a percutaneous pharmaceutical preparation for external use (title, abstract). Yamada teaches that animal fats and Vaseline are functionally equivalent pharmaceutical base components (column 3, lines 33-50).

With regard to instant claim 19, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have modified Tein's topical pharmaceutical preparation by substituting the Vaseline with animal fat. It would have been obvious to do so because Vaseline and animal fat are functionally equivalent pharmaceutical bases for topical use as taught by Yamada (column 3, lines 33-50). The skilled artisan would have been motivated to do so in order modify the feel and occlusivity of the pharmaceutical base. The skilled artisan would have had an expectation of success because Vaseline and animal fats were recognized as functionally equivalent bases for topically applied pharmaceuticals as taught by Yamada (column 3, lines 33-50).

Claims 1, 4- 6, 8, 12, 13, and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 3,932,610 (Rudy, 1976) in light of *The American Heritage Dictionary* definition for "dissolve."

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Summary of the claims: The instant claims are drawn to a composition which does not comprise fragrant material (instant claim 1). The composition consists essentially of a water soluble organic medium and an oily material which is solid at room temperature (instant claim 1). The oily solid may be rosin (instant claim 6). The composition has the chemical features of dissolving or dispersing in water and the composition may actually be dissolved or dispersed in water (instant claims 1, 5, 12 and 13). The oily material may also be a wax (instant claim 18). The ratio of the water soluble organic medium to oily material is recited (instant claims 4, 8, 16, and 17).

Example 22 of Rudy discloses a shampoo composition which comprises hydrogenated rosin (i.e. an oily material which is solid at room temperature) and the water soluble medium, hydroxypropyl cellulose. The composition comprises water and surfactants. Thus, the composition would have the ability to dissolve and disperse in water and is dissolved and dispersed in water (column 8, Table IV). As evidenced by *The American Heritage Dictionary* definition for “dissolve,” “dissolve” means to break up or disperse. Since the composition of Example 22 of Rudy comprises surfactants, it would naturally flow from chemical principles that the oil components of the hair grooming agent would be dispersed in the water of the shampoo. This assertion is further supported by Rudy’s teaching that the solvent system of the shampoo retains the hair grooming agent in solution (column 4, lines 20-25). Thus, one of ordinary skill in the art would recognize that the composition of Example 22 is both dissolved and dispersed in the water of the shampoo formulation.

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Rudy goes on to teach that perfume is an adjuvant which may be further added to the shampoo composition if desired (column 6, lines 50-60). Rudy further teaches that the hydroxypropyl cellulose is a hydrophilic thickener which may comprise 0.1-10 percent of the hair grooming agent (column 6, lines 40-50). The thickener prevents localized deposition of the hair grooming agent and promotes even distribution of the hair growing agent throughout the hair (column 6, lines 40-50). Rudy goes on to teach that the amount of hair grooming agent (i.e. rosin) comprise 1.0 to 60 percent of the composition by weight (column 5, lines 5-10). Thus the ratio of organic medium ranges from 0.1 to 1,000 parts by weight with respect to 100 parts by weight of said oily material. Rudy teaches that wood rosin is a material which, in general, imparts bodying or set holding properties to the hair (column 5, lines 10-25).

Rudy teaches inclusion of waxy materials such a cocoamide, ethoxylated lanolin, stearyl amide in the composition in order to provide body and conditioning effects to the hair (column 5, lines 40-56). Inclusion of waxes also imparts ease of combing effects to the hair (column 5, lines 40-56).

Example 22 of Rudy does not embody a composition which his free of fragrant material as set forth by instant claim 1.

Example 22 of Rudy does not embody a composition which comprises a wax as the oily material as set forth by instant claim 18.

Example 22 of Rudy does not embody a composition consisting essentially of water-soluble organic medium in a range of 10-100 parts by weight with respect to 100 parts by weight of oily material as set forth by instant claim 4.

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Example 22 of Rudy does not embody a composition consisting essentially of water-soluble organic medium in a range of 10-100 parts by weight with respect to 100 parts by weight of oily material as set forth by instant claim 8.

Example 22 of Rudy does not embody a composition consisting essentially of water-soluble organic medium in 10 parts by weight with respect to 100 parts by weight of oily material as set forth by instant claim 16.

Example 22 of Rudy does not embody a composition consisting essentially of water-soluble organic medium in 100 parts by weight with respect to 100 parts by weight of oily material as set forth by instant claim 17.

With regard to instant claim 1, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have looked to Rudy's teachings and removed the optional perfume adjuvant from Rudy's shampoo composition because Rudy teaches that the perfume may be removed if desired. The skilled artisan would have been motivated to do so in order to formulate a shampoo that does not aggravate perfume allergies and is more socially acceptable to the workplace because it does not provide an overpowering "perfume" smell.

With regard to instant claim 18, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have looked Rudy's teachings and modified Rudy's composition by adding the waxes, cocoamide, ethoxylated lanolin, stearyl amide, to the shampoo composition to provide body and condition effects to the hair as taught by Rudy (column 5, lines 40-56). The skilled artisan would have been motivated to do so in order to improve conditioning and

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combing effects of the shampoo composition on hair (column 5, lines 40-56). The skilled artisan would have been further motivated to do so in order to improve the amount of body the composition imparts to hair (column 5, lines 40-56).

With regard to instant claims 4, 8, 16 and 17, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have looked to Rudy's teachings and modified Rudy's composition by adjusting to the ratio of water soluble organic medium to be in a range of 10-100 parts by weight with respect to 100 parts by weight of oily material, 10 parts by weight with respect to 100 parts by weight of oily material, or 100 parts by weight with respect to 100 parts by weight of oily material because Rudy teaches that the water soluble organic medium to be in range of 0.1-1,000 parts per 100 parts by weight oily material (column 6, lines 40-50; column 5, lines 5-10). The skilled artisan would have been motivated to do so in order to ensure that the hair grooming agent is evenly dispersed throughout the hair by utilizing the correct amount of hydrophilic thickener. The skilled artisan would have been further motivated to do so in order to provide an appropriate amount of hair grooming agent which provides body and set-holding properties to the hair.

The adjustment of particular conventional working conditions (e.g. determining result effective amounts of the water soluble organic medium (i.e. hydroxypropyl cellulose) and solid oily material (i.e. rosin/wood resin)) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the ordinary artisan with said artisan recognizing that the hydroxypropyl cellulose provides thickening even deposition of the composition on the hair while the rosin/wood resin

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provides the composition with the ability to provide set-holding and body to the hair as taught by Rudy.

Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rudy in light of *The American Heritage Dictionary* definition for “dissolve,” as applied to claims 1, 4- 6, 8, 12, 13, and 16-18 above, and in view of US Patent No. 6,649,154 (Yoshida, 2003).

Rudy is relied upon as above. Rudy teaches a shampoo with a hair growing agent dissolved into it (abstract). Rudy goes on to teach methyl cellulose and hydroxypropyl cellulose are hydrophilic thickeners which provide even deposition of the hair grooming agent onto the hair (column 6, lines 40-50).

Rudy does not teach that the water soluble organic medium is carboxymethyl cellulose as set forth by instant claim 3.

Rudy does not teach that the water soluble organic medium is carboxymethyl cellulose as set forth by instant claim 7.

Yoshida teaches a cosmetic hairdressing composition (title). Yoshida teaches that the hair dressing composition comprises thickeners such as carboxymethyl cellulose and hydroxypropyl cellulose (column 6, lines 4-15).

With regard to instant claims 3 and 7, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have modified Rudy’s composition by substituting the hydroxypropyl cellulose thickener taught by Rudy with the functionally equivalent thickener carboxymethyl cellulose as taught by

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Yoshida. The skilled artisan would have been motivated to do so in order to alter the viscosity of the hair composition and the deposition of the hair grooming agent onto the hair (column 6, lines 40-50). The skilled artisan would have had the expectation of success for such a substitution because carboxymethyl cellulose and hydroxypropyl cellulose are functionally equivalent thickeners utilized in hair compositions as taught by Yoshida (Yoshida-column 6, lines 4-15).

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rudy in light of *The American Heritage Dictionary* definition for “dissolve,” as applied to claims 1, 4-6, 8, 12, 13, and 16-18 above, and in view of US Patent No. 4,253,993 (Ramsey, 1981), the *Cambridge Dictionary of American English* definition for “powder,” and Shampoo accessed from

[://web.archive.org/web/20031204072657/http://www.mydreadlocks.com/shampoo-dreadlocks.html](http://web.archive.org/web/20031204072657/http://www.mydreadlocks.com/shampoo-dreadlocks.html), archived 12/04/20003, accessed 3/10/2010.

Summary of the claim: Instant claim 2 requires that the composition of claim 1 be in the form of a powder.

Rudy is relied upon as above.

Rudy does not teach that the shampoo compositions are in the form of a powder as set forth by instant claim 2.

Ramsey teaches that shampoo compositions in the prior art take a variety of forms including liquids, pastes, gels, and powders (column 1, lines 5-10). Ramsey goes on to teach a shampoo composition in the form of flakes (Abstract). The *Cambridge*

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Dictionary of American English defines powder to mean, " a loose, dry substance of extremely small pieces, usually made by breaking up something into smaller parts and crushing them." Notably, Ramsey's shampoo flakes are taught to be particles which range in size from 208 microns-803 microns (i.e. the particles are extremely small) (column 4, lines 20-30). Ramsey teaches that roller milling followed by drum drying (to break up the sheets) is the process used to form the flakes (column 3, lines 5-15). To control the size sieving, grinding, and recycling are used (column 3, lines 20-30). Thus, one of ordinary skill in the art would recognize Ramsey's shampoo flakes as powder due to their small size and method of formation. Ramsey teaches that shampoo flakes are good to clean hair, provide good lather speed, and stability for lathering hair (column 1, lines 15-25).

"Shampoo" teaches that dry shampoos are great for camping because they take up so little space and are less heavy (page 2 of 5, paragraph 10).

With regard to instant claim 2, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have formulated the shampoo of Rudy into a shampoo flake/powder as taught by Ramsey because Ramsey teaches that shampoo compositions known in the art come in a variety of forms such as liquids, pastes, gels, and powders (Ramsey-column 1, lines 5-10). Selection of the physical form of the shampoo is a design choice as taught by Ramsey (Ramsey-column 1, lines 5-10). The skilled artisan would have been motivated to choose to formulate Rudy's shampoo as a flake/powder composition because Shampoo

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teaches that flake/powder shampoos are good for camping because they take up less space and are light weight (page 2 of 5, paragraph 10).

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rudy in light of *The American Heritage Dictionary* definition for “dissolve,” as applied to claims 1, 4-6, 8, 12, 13, and 16-18 above, and in view of US Patent No. 6,190,680 (Sakurada, 2001), US Patent No. 6,342,209 (Patil, 2002) and US Patent No. 5,770,187 (Hasebe, 1998).

Summary of the claim: The oily material of the hair costumizer is recited to be Vaseline.

Rudy is relied upon as above.

Rudy does not that the oily material is Vaseline as set forth by instant claim 20.

Sakurada teaches an oily composition which may be used in cosmetics, including shampoos (column 10, lines 30-35; title). Sakurada further teaches that rosin and Vaseline are functionally equivalent oily components (column 7, lines 25-40).

Patil teaches that the cosmetic arts recognized hydrogenated rosin as a film former (column 2, lines 35-40; column 5, lines 5-15).

Hasebe teaches that that the cosmetic arts recognized Vaseline as a film former (column 2, lines 50-60).

With regard to instant claim 20, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have modified Rudy's shampoo composition by substituting Vaseline for the hydrogenated rosin

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because Vaseline and hydrogenated rosin are functionally equivalent oily materials which are film-formers that may be utilized in shampoos (Sakurada- column 10, lines 30-35, title; Patel-column 2, lines 35-40, column 5, lines 5-15; Hasebe column 2, lines 50-60). The skilled artisan would have been motivated to do so in order to modify the feel, body, and hair setting properties of the shampoo formulation. The skilled artisan would have had an expectation of success because Vaseline and hydrogenated rosin are functionally equivalent oily materials which are recognized as film formers in the cosmetic arts.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rudy in light of *The American Heritage Dictionary* definition for “dissolve,” as applied to claims 1, 4-6, 8, 12, 13, and 16-18 above, and in view of US Patent No. 6,190,680 (Sakurada, 2001), Japanese Soap and Its Manufacture as published in the *Journal of the American Oil Chemist's Society* in 1932, and Zile as published in the *Journal of the American Oil Chemist's Society* in 1945.

Summary of the claim: The oily material of the hair costumizer is recited to be animal fat.

Rudy is relied upon as above.

Rudy does not teach that the oily material is Vaseline as set forth by instant claim 20.

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Sakurada teaches an oily composition which may be used in cosmetics including shampoos (column 10, lines 30-35; title). Sakurada further teaches that rosin and harden fish oil are functionally equivalent oily components (column 7, lines 25-30).

Japanese Soap and Its Manufacture teaches that hardened fish oil is taking the place of tallow in soap-making. Japanese Soap and Its Manufacture goes on to teach that in the near future hardened fish oil will be used instead of tallow in soap-making and that Japan will no longer need to import tallow (page 137, column 1, paragraph 3).

Zile teaches that addition of hydrogenated rosin to tallow soaps improved the amount and stability of the lather (page 332, second column, last paragraph and table 2). Zile goes on to teach that modified rosin (including hydrogenated rosin) increases the rate of solubility of the soap when used as a replacement for part of the fat (i.e. tallow) (page 334, column 2, paragraph 3).

With regard to instant claim 19, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have modified Rudy's shampoo composition by substituting hardened fish oil for the hydrogenated rosin because hardened fish oil and hydrogenated rosin are functionally equivalent oily materials which are tallow/fat replacements that may be utilized in shampoos (Sakurada- column 10, lines 25-30, title; Japanese Soap and its Manufacture- page 137, column 1, paragraph 3; Zile- page 332, second column, last paragraph and table 2; page 334, column 2, paragraph 3). The skilled artisan would have been motivated to do so in order to modify the feel, body, and hair setting properties of the shampoo formulation. The skilled artisan would have had an expectation of success because

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hardened fish oil and hydrogenated rosin are functionally equivalent oily materials which have similar function in soaps. Specifically, hardened fish oil and hydrogenated rosin are both utilized as replacements for tallow in soaps.

Response to Arguments

Applicant alleges that support for the amendment to claim 1 can be found at page 7, paragraph 29 of the instant specification (Reply, page 5, paragraph 4).

Applicant alleges that since M.P.E.P. § 2173.05(i) states that if an alternative element is positively recited in the specification, they may be explicitly excluded in the claims (Reply, page 5, paragraph 4). Applicant further states that since “fragrant material is a positively recited alternative element, it may be excluded from the claims (Reply, page 5, paragraph 4).

Applicant’s arguments have been considered but are not persuasive.

M.P.E.P. § 2173.05 (i) discusses negative claim limitations. M.P.E.P. § 2173.05 (i) states, “Any negative limitation or exclusionary proviso must have basis in the original disclosure.” M.P.E.P. § 2173.05 (i) further directs the examiner to reject a negative limitation which does not have basis in the original disclosure. M.P.E.P. § 2163 states, “To satisfy the written description requirement , a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of claimed invention. M.P.E.P. § 2163 goes on to state that the written description requirement prevents an applicant from claiming subject matter that was not adequately described in the specification as filed. New or amended claims which introduce elements or limitations which are not supported by the

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as-filed disclosure violate the written description requirement. Newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure (M.P.E.P. § 2163). In the instant case, fragrant materials are disclosed among a list of a variety of materials that *may be* included in the hair composition. There is no proper support in the specification or claims as filed for the specific exclusion of fragrant materials from the variety of disclosed materials that may be included in the hair composition.

Instant claim 1 now recites limitations, which were not clearly disclosed in the specification as filed, and now change the scope of the instant disclosure as filed. Such limitations recited in amended claim 1, do not appear in the specification, as filed, introduce new concepts and violate the description requirement of the first paragraph of 35 U.S.C 112.

Applicant traverses the rejections of instant claims 1-8, 12-13, and 16-17 as being unpatentable over Creutz (i.e. "Cruetz" as misspelled in the Reply), Aldercroft, and Sop as evidenced by MSN Encarta dictionary for powder and the Compact Oxford English Dictionary for granule (Reply, page 5, last paragraph). Applicant alleges that claim 1 is the sole independent claim and that instant claim 1 recites that the composition does not comprise a fragrant material (Reply, page 6, paragraphs 1-3). Applicant alleges that the Creutz reference teaches away from the claimed composition because the Creutz reference requires that a fragrance is required by Cruetz (Reply,

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page 6, paragraph 3). Applicant asserts that the claims are now in condition for allowance (Reply, page 5, last paragraph).

Applicant's arguments have been considered but are not persuasive.

Applicant argument pertaining to the Creutz reference is moot in light of the new grounds of rejection above. Notably, the newly applied Tein reference does not teach inclusion of a fragrance (i.e. a fragrant material). The Rudy reference teaches that fragrance/perfumes are optional adjuvants which may be added if desired (Rudy-column 6, lines 50-60). As discussed in the 35 USC 103(a) rejection above, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have looked to Rudy's teachings and removed the optional perfume adjuvant from Rudy's shampoo composition in order not to aggravate perfume allergies and create a more socially acceptable shampoo for appropriate for the workplace because it does not provide an overpowering "perfume" smell.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LORI MATTISON whose telephone number is (571)270-5866. The examiner can normally be reached on 8am-6pm (Monday-Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne (Bonnie) Eyler can be reached on (571)272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LORI MATTISON/

Examiner, Art Unit 1619

/Anne Marie Grunberg/

Supervisory Patent Examiner, Art Unit 1661

Conclusion